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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of: Jay S. WALKER et al.)	
)	
For: METHOD AND APPARATUS FOR)	
PROVIDING CROSS-BENEFITS VIA)	
A CENTRAL AUTHORITY)	
)	Examiner: Not Yet Assigned
)	
Serial No.: Not Yet Assigned)	Group Art Unit: Not Yet Assigned
)	
Filing Date: March 22, 1999)	Docket No.: WD2-99-006

Assistant Commissioner for Patents
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Sir:

Applicants submit herewith patents, publications or other information of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a thorough search has been made, an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists. Nor shall the filing of this information disclosure statement be construed as an admission against interest in any manner.

This Information Disclosure Statement is filed in accordance with 37 C.F.R. §§1.56, 1.97 and 1.98. The items listed below and on the accompanying Form PTO-1449 may be deemed to be pertinent to the above-identified application and are made of record to assist the Patent and Trademark Office in its examination of this application. The Examiner is respectfully requested to fully consider these items and to independently ascertain their teaching.

- A. U.S. Patent No. 4,491,725 entitled "MEDICAL INSURANCE VERIFICATION AND PROCESSING SYSTEM" issued to Lawrence E. Pritchard on January 1, 1985.
- B. U.S. Patent No. 4,667,292 entitled "MEDICAL REIMBURSEMENT COMPUTER SYSTEM" issued to William C. Mohlenbrock et al. on May 19, 1987.
- C. U.S. Patent No. 4,740,119 entitled "PURCHASING SYSTEM WITH REBATE FEATURE" issued to Jeffery M. Cohen et al. on June 7, 1988.
- D. U.S. Patent No. 4,982,346 entitled "MALL PROMOTION NETWORK APPARATUS AND METHOD" issued to Kenneth P. Girouard et al. on January 1, 1991.
- E. U.S. Patent No. RE. 34,380 entitled "METHOD AND APPARATUS FOR APPLYING MESSAGES IN A TELECOMMUNICATIONS NETWORK" issued to Neil F. Sleeve on September 14, 1993.
- F. U.S. Patent No. 5,287,268 entitled "CENTRALIZED CONSUMER CASH VALUE ACCUMULATION SYSTEM FOR MULTIPLE MERCHANTS" issued to Patrick D. McCarthy on February 15, 1994.
- G. U.S. Patent No. 5,319,542 entitled "SYSTEM FOR ORDERING ITEMS USING AN ELECTRIC CATALOGUE" issued to John E. King et al. on June 7, 1994.
- H. U.S. Patent No. 5,333,186 entitled "TELECOMMUNICATION CALL BILLING METHOD AND APPARATUS" issued to Shiv K. Gupta on July 26, 1994.
- I. U.S. Patent No. 5,619,558 entitled "ATM SEGMENT OF ONE MARKETING METHOD" issued to Elizabeth A. Jheeta on April 8, 1997.
- J. U.S. Patent No. 5,652,784 entitled "AUTOMATIC TELEPHONE ADVERTIZING PROVIDED IN LIEU OF DIAL-TONE" issued to Georgina Borbon Blen et al. on July 29, 1997.

- K. U.S. Patent No. 5,694,551 entitled "COMPUTER INTEGRATION NETWORK FOR CHANNELING CUSTOMER ORDERS THROUGH A CENTRALIZED COMPUTER TO VARIOUS SUPPLIERS" issued to John D. Doyle et al. on December 2, 1997.
- L. PCT No. WO 98/06050 entitled "SYSTEM AND METHOD FOR A TARGETED PAYMENT SYSTEM DISCOUNT PROGRAM" issued to Roger L. Pierce et al. on February 12, 1998.
- M. Pagoda, Dianne M., "G.E.C.C. offers credit card with discounts, rebates; General Electric Corp." WWD (Women's Wear Daily), Vol.164; No. 46; pg. 7, September 3, 1992.
- N. Kristof, Kathy "CARD SHARKS ARE IN SEASON; BE WARY OF DISCOUNTS AND REBATES AS YOU SHOP AROUND FOR GOOD CREDIT DEALS", Chicago Tribune, pg. 9; November 23, 1993.
- O. U.S. Patent No. 5,724,521 entitled "METHOD AND APPARATUS FOR PROVIDING ELECTRONIC ADVERTISEMENTS TO END USERS IN A CONSUMER BEST-FIT PRICING MANNER" issued to Rick Dedrick on March 3, 1998.
- P. U.S. Patent 5,752,238 entitled "CONSUMER-DRIVEN ELECTRONIC INFORMATION PRICING MECHANISM" issued to Rick Dedrick on May 12, 1998.
- Q. U.S. Patent No. 5,794,210 entitled "ATTENTION BROKERAGE" issued to A. Nathaniel Goldhaber et al. on August 11, 1998.
- R. U.S. Patent No. 5,794,221 entitled "INTERNET BILLING METHOD" issued to Andrew Egendorf on August 11, 1998.
- S. U.S. Patent No. 5,819,092 entitled "ONLINE SERVICE DEVELOPMENT TOOL WITH FEE SETTING CAPABILITIES" issued to Charles H. Ferguson et al. October 6, 1998.
- T. U.S. Patent No. 5,864,822 entitled "BENEFITS TRACKING AND CORRELATION SYSTEM FOR USE WITH THIRD-PARTY ENABLING ORGANIZATION" issued to Bernard R. Baker, III. On January 26, 1999.

- U. Ellis, Stephen "CREDIT CARD FIRMS DRIVE DOWN COSTS" , Sunday Times, February 27, 1994.
- V. Block, Valerie "GM Turns up the Heat with Plan to Cross-Sell Some Financial Products", The American Banker, pg. 16, November 18, 1994.
- W. Wildstrom, Stephen H. "PAGERS THAT CAN SPELL IT ALL OUT", Business Week, pg. 16, January 16, 1995.
- X. Meece, Mickey "BIG FINANCE COMPANIES MAY WANT PIECE OF LIMITED'S PRIVATE-LABEL CARD PROGRAM", The American Banker, pg. 8, April 12, 1995.
- Y. Schrage, michael "FREE STUFF! PREDATORY PRICING OR CREATIVE CROSS-PROMOTION? YOU BE THE JUDGE; THE BETA VERSION; INDUSTRY TREND OR EVENT" Marketing Computers, Vol 15, No. 9. Pg. 24, October 1995.
- Z. Marshall, Kyle "MORE PHONE CHOICES RING IN", The News and Observer, pg. D1, August 13, 1996.
- AA. Wessel, Harry "REWARDING EXPERIENCE?; CREDIT CARDS OFFERING BONUSES NOT FOR EVERYONE" Chicago Tribune, pg. 1, November 4, 1996.
- BB. Selasky, Susan "EASY-TO-SWALLOW SAVINGS; DINER CREDIT CARDS SERVE WIDE MENU OF DISCOUNTS", Pittsburgh Post-Gazette, pg. F-2, December 5, 1996.
- CC. "MERGER CREATES ALLIANCE DATA" , Credit Risk Management Report, Vol. 6 No. 25, December 16, 1996.
- DD. Higgins, Stephen "DIGITAL PHONE SERVICE ON THE WAY", New Haven Register, January 7, 1997.
- EE. Kerstetter, Jim "E-COMMERCE UPDATES GET INTELLIGENT AGENTS; ELECTRONIC COMMERCE; BRIEF ARTICLE PRODUCT", PC Week No. 5, Vol. 14;pg.6; February 3, 1997.
- FF. Barlow, Rick "RELATIONSHIP MARKETING: COALATION MARKETING IS COMING BACK:; Brandweek, April 28, 1997.
- GG. Gilligan, Gregory J. "CREDIT CARDS FROM RETAIL STORES A MIXED BLESSING FOR SHOPPERS", pg. E-1, July 20, 1997.

- HH. Simon, Ruth "MAKE SURE YOUR REBATE CARD STILL DELIVERS THE GOODS", MONEY, pg. 42, August 1997.
- II. Fitzgerald, Beth "NEW JERSEY-BASED SCA HELPS PRIVATE LABEL CREDIT CARDS TAKE OFF" The Star Ledger, August 4, 1997.
- JJ. Sanders, Edmund "TRICKY BUSINESS; THE MAGIC OF REBATE CARDS CAN QUICKLY DISAPPEAR" Chicago Tribune, pg. 1, August 18, 1997.
- KK. "SNET Cellular Value Plans", November 1, 1997.
- LL. Wijnen, Renee "CENDANT EYES CROSS-MARKETING OPPORTUNITIES; CUC INTERNATIONAL -HFS INC. MERGER EXPECTED TO YIELD AN ADDITIONAL 2 MILLION CLUB MEMBERS" DM News, pg. 4, February 2, 1998.
- MM. "CARDHOLDERS THINK BIG", Bank Marketing International, pg. 8, March 1998.
- NN. Wald, Matthew "SPENDING IT; UNTYING CELLULAR PHONES FROM THOSE ANNUAL CONTRACTS", The New York Times, Sec. 3 pg. 10 col. 2, March 15, 1998.
- OO. "AMERICAN EAGLE OUTFITTERS, INC. INTRODUCES THE FIRST CLEAR CREDIT CARD", PR Newswire, March 26, 1998.
- PP. Ling, The Hooi "PRICES OF HANDPHONES DIVE, THANKS TO CROSS-SUBSIDIES", Business Times, pg. 1, April 8, 1998.
- QQ. "CARD BRIEFS: BENEFICIAL, CASUAL MALE TEAM UP ON CARD", The American Banker, pg. 20, May 4, 1998.
- RR. "POINTS EARN LITTLE CREDIT AS CARDHOLDERS FAIL TO CASH IN" Birmingham Post. Pg. 32, May 9, 1998.
- SS. "JAY JACOBS INC. INTRODUCES PRIVATE LABEL CARD", Business Wire, May 18, 1998.
- TT. "WELLSPARK GROUP LAUNCHES V.I.P. REWARDS; THE MOST COMPREHENSIVE RELATIONSHIP MARKETING PROGRAM EVER CREATED BY A MALL DEVELOPER", Business Wire, May 19, 1998.
- UU. "SHOPPERS CHARGE ACCOUNTS CO. TO ADMINISTER PRIVATE LABEL CREDIT CARD FOR LEW MAGRAM LTD.; PROGRAM MARKS

- SCA'S ENTRY INTO RETAIL CATALOG/MAIL ORDER INDUSTRY", PR Newswire, June 29, 1998.
- VV. Quittner, Joshua "CELL PHONES AT 7-11?; ALMOST EVERYONE IS SELLING WIRELESS SERVICE THESE DAYS; HERE'S HOW TO GET THE RIGHT DEAL", TIME, pg. 95 July 6, 1998.
- WW. Cruz, Humberto "THE SAVINGS GAME", The Cincinnati Enquirer, pg. B16, August 31, 1998.
- XX. "FILENE'S" Credit Card Application, September 1998.
- YY. "CLUB MACY'S" Charge Account Application, September 1998.
- ZZ. Kingson Bloom, Jennifer "WAL-MART on Retail Road Less Traveled: Cobranding", The American Banker, September 11, 1998.
- AAA. Elkin, Tobi "PROMOTIONS: MasterCard Wins Coveted On-Pack Real Estate In Tie-in with Microsoft", BRANDWEEK, September 14, 1998.
- BBB. "TO BUSINESS AND TECHNOLOGY EDITORS" PR Newswire, October 28, 1998.
- CCC. Fitzgerald, Kate "DUAL-FUNCTION CARDS LATEST PITCH TO CALL IN HOLDERS"" Card Marketing (<http://cardmarketing.faulknergray.com>), November 1998.
- DDD. Griffin, Kate "ISSUERS CHARGE AHEAD TO FOCUS ON PRICE VS. BRAND", Card Marketing (<http://cardmarketing.faulknergray.com>), November 1998.
- EEE. "RETAIL CARDS: ATTENTION KMART CARD HOLDERS: 6% BACK IS DEAD A NEW PACKAGE OF PERKS IS COMING", Credit Card News, November 1, 1998.
- FFF. "COMPETITION: FIRST USA, WITH ITS MICROSOFT PACT, IS KING OF THE INTERNET", Credit Card News, November 1, 1998.
- GGG. Cowell, Alan "AMERICA'S TURN TO COLONIZE; CREDITCARD ISSUERS INVADE BRITAIN, WITH U.S. FIREPOWER", The New York Times, Section C; pg. 1 Col. 2, November 12, 1998.
- HHH. "#1 ONLINE DEPARTMENT STORE JOINS CLICKREWARDS IN TIME FOR THE HOLIDAYS; AZAZZ.COM TO SUPPLY NAME-BRAND MERCHANDISE FOR NETCENTIVES' CLICKREWARDS CATALOG AND

- CLICKREWARDS; MEMBERS CAN NOW EARN GENEROUS
CLICKMILES PROMOTIONS WITHIN THE AZAZZ.COM INTERNET
DEPARTMENT STORE", PR Newswire, November 27, 1998.
- III. Shermach, Kelly "PARTNERSHIPS HELP ISSUERS WEAVE WEB
CONCEPTS", Card Marketing (<http://cardmarketing.faulknergray.com>), Download
date November 1998.
- JJJ. "LARGEST INTERNET AS DEAL SIGNED", Bank Marketing International,
December 1998.
- KKK. "'AMAZON.COM AND NETFLIX.COM ESTABLISH PROMOTIONAL
RELATIONSHIP FOR THE SALE AND RENTAL OF DVD TITLES", Business
Wire, December 4, 1998.
- LLL. "AT SPORTS SUPERSTORE ONLINE, SHOPPERS GET MORE FOR THEIR
MONEY; 10, 1000 REASONS TO SHOP AT SPORTS SUPERSTORE
ONLINE", Business Wire, December 4, 1998.
- MMM. Korry, Elaine "CREDIT CARD ENTICEMENTS", NPR MORNING EDITION
Transcript #98122308-210, December 23, 1998.
- NNN. Holton, Lisa "CABLE EFFORTS HELP ISSUERS TUNE INTO NEW
MARKETS", Card Marketing, (<http://cardmarketing.faulknergray.com>), download date
January 1999.
- OOO. "NORTHWEST AIRLINES. SPRINT ENTER INTO MILEAGE
PARTNERSHIP; CONSUMERS CAN EARN UP TO 16,500 FREQUENT
FLYER MILES THROUGH WIDE RANGE OF COMMUNICATIONS
SERVICES—LONG DISTANCE, INTERNET, PAGING AND ULTIMATELY
SPRINT PCS", PR Newswire January 5, 1999.
- PPP. "FREE FROM NEXTCARD-THE AGES OF MYST",
(<http://www.nextcard.com/ages/agesofmyst.htm>), download date January 6, 1999.
- QQQ. Kreinin Souccar, Miriam "EPIDEMIC OF RATE SHOPPING SPURS A
SEARCH FOR REMEDIES", The American Banker, January 7, 1999.
- RRR. "INTRODUCING E.CARD VISA",
(<http://app1.firstusa.com/pcards/ecard/index1.cfm?mkid-6j08&promo=1ec01ec10>), January 11,
1999.

- SSS. "ABOUT SMARTSAVE", (<http://www.savesmart.com/about/savesmart.html>), download date January 12, 1999.
- TTT. "THE TRIP.COM, VISA LAUNCH REWARD PROGRAM", (<http://www.internetnews.com/ec-news/1999/01/1302-trip.html>), download date January 13, 1999.
- UUU. "ABOUT CLICKREWARDS THE BEST WAY TO EARN MILES", (<http://www.clickrewards.com/about.html>), download date January 13, 1999.
- VVV. "MY SIMON; WORLD'S MOST INTELLIGENT SHOPPING AGENT", (<http://www.mysimon.com>), download date January 13, 1999.
- WWW. "JOIN AOL LONG DISTANCE AND THIS IS WHAT YOU WILL RECEIVE", America Online: Johnny Axxe, download date January 13, 1999.
- XXX. "THE NEW AE CARD", (<http://www.aeotfitters.com/crd.htm>), download date January 14, 1999.
- YYY. "ENDEAVOUR TRAVEL; TS60 EIGHT DAY NEW ZEALAND FLY DRIVE PACKAGE", (<http://www.anzac.com/endvr/ts60.html>), download date January 17, 1999.
- ZZZ. "ALTAVISTA SIGNUP; ALTAVISTA'S SPECIAL OFFER TO YOU", (http://altavista.iname.com/promoxtra_alta.html), download date January 17, 1999.
- AAAA. "RENT FROM NETFLIX.COMBUY FROM AMAZON.COM", (http://www.netflix.com/teaming_with_amazonasp?si) download date January 17, 1999.
- BBBB. "SPRINT SENSE DAY AND YOUR TITANIC VIDEOCASSETTE", (<http://csg.sprint.com/titanic>) download date January 18, 1999.
- CCCC. O' Brien, Timothy "THE MARKETS: MARKET PLACE—TAKING THE DANGEROUS OF RISK; CHASE SAYS MODELS HELPED IT AVOID FINANCIAL MINEFIELDS", The New York Times, Sec. C; pg. 1. Col 2, January 20, 1999.
- DDDD. "VISA, TRAVEL WEB ENTER ONLINE MARKETING PARTNERSHIP", (<http://www.internetnews.com/ec-news/1999>) download date January 25, 1999.
- EEEE. "KIOSK ISSUE CARDS FOR LOYALTY AND CREDIT" RT News, (www.retailtech.com), February 1999.

FFFF. Feldman, Amy "PAYING WITH PLASTIC NOT SUCH SMART IDEA", New York Daily News Online (<http://www.nydailynew>) download date March 22, 1999.

1. ☐ Any copy of the items listed above and on the enclosed copy of Form PTO-1449 that is not enclosed with this Information Disclosure Statement was previously cited by or submitted to the Patent and Trademark Office in the prior ☐ Continuation, ☐ Divisional or ☐ Continuation in part application filed under 37 C.F.R. §§ 1.53 or 1.60, U.S. Serial No. _____, filed _____.
2. ☐ For each of the following items listed above and on the enclosed copy of Form PTO-1449 that is not in the English language, a European Search Report from a counterpart European application is enclosed. Such items are marked as reference letter(s): _____.
3. ☐ For each of the following items listed above and on the enclosed copy of Form PTO-1449 that is not in the English language, a concise explanation of the relevance of that item is incorporated in the specification of the above-identified application. Such items are marked as reference letter(s): _____.
4. ☒ In addition to the citations listed above, applicants respectfully direct the Examiner's attention to the following U.S. patent applications, which are commonly assigned to the assignee of the instant application, and which may be deemed pertinent to the instant application:

<u>Serial No.</u>	<u>Inventors</u>	<u>Filing Date</u>	<u>Group Art Unit</u>	<u>Examiner's Init.</u>
09/166,367	Walker et al.	10/15/98		
09/166,405	Walker et al.	10/05/98		
09/205,663	Walker et al.	12/04/98		
09/223,901	Walker et al.	12/31/98		
09/223,903	Walker et al.	12/31/98		
09/221,099	Walker et al.	12/28/98		

The Examiner is respectfully requested to fully consider and independently ascertain the teachings and relevance of those applications with respect to the instant application. These applications have not been listed on the accompanying Form PTO-1449 in order to preserve their secrecy during the course of their prosecution.

5. ☒ No fee is believed to be due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with:
- ☒ 37 C.F.R. §1.97(b)(1), within three months of the filing date of the above-identified application.
 - ☐ 37 C.F.R. §1.97(b)(2), within three months of the date of entry into the national stage as set forth in §1.491.
 - ☐ 37 C.F.R. §1.97(b)(3), before the mailing date of a first Office Action on the merits.
6. ☐ No fee is believed to be due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. 1.97(c), after the period specified in paragraph 5 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action), and is accompanied by one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 10 below.
7. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c) after the period specified in paragraph 5 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action). The fee due under 37 C.F.R. §1.17(p) is to be paid as set forth in paragraph 11 below.
8. ☐ A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in accordance with 37 C.F.R. §1.97(d), after the mailing date of a final action or a Notice of Allowance, but before the payment of the issue fee, and is accompanied by:
- a. one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 10 below; and
 - b. the attached petition requesting consideration of this Information Disclosure Statement; and
 - c. the fee due under 37 C.F.R. §1.17(i)(1) which is paid as set forth in paragraph 11 below.

9. ☐ A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in compliance with:

- ☐ 37 C.F.R. §1.313(b)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition to Withdraw Application from Issue;
- ☐ 37 C.F.R. §1.313(b)(5), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Continuation application upon abandonment of the instant application and is accompanied by the attached Petition to Withdraw Application from Issue.
- ☐ The fee due under 37 C.F.R. §1.17(i)(1) is paid as set forth in paragraph 11 below.

10. ☐ I hereby certify:

- ☐ that each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. A copy of such communication is enclosed.
- ☐ that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

11. ☐ Please accept payment of the fees due as indicated below:

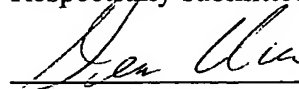
- ☐ A check in the amount of \$240.00 is enclosed in payment of the fee due under 37 C.F.R. 1.17(p).
- ☐ The Commissioner is hereby authorized to charge \$240.00 to Deposit Account No. 50-0271 in payment of the fee due under 37 C.F.R. §1.17(p). A duplicate copy of this sheet is attached for such purpose
- ☐ A check in the amount of \$130.00 is enclosed in payment of the fee due under 37 C.F.R. §1.17(i)(1).
- ☐ The Commissioner is authorized to charge \$130.00 to Deposit Account No. 50-0271 in payment of the fee due under 37 C.F.R. §1.17(i)(1). A duplicate copy of this sheet is attached.

12. [X] The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 50-0271. A copy of this authorization is attached.

March 22, 1999

Date

Respectfully submitted,



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